

REMARKS

This Response is submitted in reply to the Office Action dated June 13, 2007, and in accordance with the personal interview on July 17, 2007. Claims 1, 3, 4, 6, 7, 11, 18, 20, 22, 25 to 27, 31 and 34 have been amended. New Claims 37 to 81 have been added. No new matter has been added by these amendments or new claims.

A Supplemental Information Disclosure Statement is submitted herewith. A Petition for a One Month Extension of Time to respond to the office action is submitted herewith. Please charge deposit account number 02-1818 for any fees associated with this Supplemental Information Disclosure Statement, this Petition for a One Month Extension of Time, these new Claims and this Response.

The Office Action rejected Claims 1 to 5, 8 to 14 and 21 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,311,976 to Yoseloff et al. ("Yoseloff"). Applicants respectfully disagree. Nonetheless, to expedite prosecution of the present application, Applicants have amended certain claims for clarity.

Yoseloff discloses a reel-type video wagering game which includes placing a wager on a first reel-slot-type video game and displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position. Upon the occurrence of a predetermined triggering event, such as with as little as a single symbol appearing on the screen, awarding at least one type of non-monetary credit (or a temporary/artificial credit having no immediately redeemable cash or prize value) to the player; (1) at the conclusion of the first game, (2) at the conclusion of a number of first games, (3) upon the occurrence of a second triggering event, (4) after collection of a predetermined number of at least one type of non-monetary credits during the first game, or (5) after collection of non-monetary credits during a set time period. Yoseloff discloses assigning a unit value or total value to the non-monetary credits, and resolving the award to the player regarding the non-monetary credit.

The gaming device of amended independent Claim 1 includes, amongst other elements, at least one processor operable to display a play of the primary game upon a wager by a player, wherein the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any outcome of the primary game and determine whether to display and provide the winning outcome in the secondary game, wherein said determination is

based upon the plurality of gaming elements provided from playing the primary game a plurality of times.

As discussed during the interview, Applicants respectfully submit that Yoseloff does not disclose providing at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any outcome of the primary game. In Yoseloff, the gaming elements for the secondary game (i.e., the non-monetary credit symbols) are provided upon the occurrence of a predetermined triggering event in the base game, such as the appearance of a single non-monetary credit symbol on the screen. On the other hand, in the gaming device of amended independent Claim 1, the gaming elements for the secondary game are provided regardless of any event in the primary game and regardless of any outcome of the primary game. For this reason alone, Applicants respectfully submit that amended independent Claim 1 is patentably distinguished over Yoseloff and in condition for allowance.

Claims 2 to 5, 8 to 14 and 21 depend directly or indirectly from independent Claim 1, are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

The Office Action rejected Claims 19, 22 to 30 under 35 U.S.C. §103(a) as being unpatentable over Yoseloff.

The Office Action states that it would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' disclosure to feature card games in all of Yoseloff's embodiments for the purpose of providing additional games of chance and creating numerous forms of bonus game play based on popular games such as Poker.

Applicants respectfully disagree and submit that it would not have been obvious to one of ordinary skill in the art at the time of Applicants' disclosure to convert the non-monetary credits of Yoseloff (which accumulate based on generated symbols) to card elements wherein the winning outcome in the secondary game is displayed and provided based upon the plurality of gaming cards provided from playing the primary game a plurality of times.

Applicants further submit that regardless of if it would or would not have been have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' disclosure to feature card games in all of Yoseloff's embodiments for the purpose of

providing additional games of chance, as described above, Yoseloff does not disclose a processor operable to display a play of the primary game upon a wager by a player, wherein the play of the primary game provides at least one of the gaming cards for the secondary game regardless of any event in the primary game and regardless of any outcome of the primary game, and determine whether to display and provide the winning outcome in the secondary game based upon the plurality of gaming cards provided from playing the primary game a plurality of times. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Yoseloff to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

On the other hand, unlike Yoseloff, dependent Claim 19 is directed to a gaming device including, amongst other elements, at least one processor operable to display a play of the primary game upon a wager by a player, wherein the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any outcome of the primary game and determine whether to display and provide the winning outcome in the secondary game, wherein said determination is based upon the plurality of gaming elements provided from playing the primary game a plurality of times, wherein the secondary game includes a secondary card game having at least one winning outcome, wherein the gaming elements include cards for the secondary card game.

Similarly, unlike Yoseloff, amended independent Claim 22 is directed to a gaming device which includes, amongst other elements, at least one processor operable to display a play of the primary game upon a wager by a player, wherein the play of the primary game provides at least one of the gaming cards for the secondary game regardless of any event in the primary game and regardless of any outcome of the primary game, and determine whether to display and provide the winning outcome in the secondary game based upon the plurality of gaming cards provided from playing the primary game a plurality of times. For these reasons, Applicants respectfully submit that dependent Claim 19 and amended independent Claim 22 are patentably distinguished over Yoseloff and in condition for allowance.

Claims 23 to 30 depend directly or indirectly from independent Claim 22, are also allowable for the reasons given with respect to Claim 22, and because of the additional features recited in these claims.

The Office Action rejected Claim 20 under 35 U.S.C. §103(a) as being unpatentable over Yoseloff in view of U.S. Patent No. 7,094,147 to Nakata et al. ("Nakata").

As stated in the Office Action, Nakata discloses a game system with embodiments featuring various versions of Tetris.

The Office Action states that it would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' disclosure to incorporate a bonus round featuring the game of Tetris for the purpose of invoking player skill and strategy to determine award payoffs in bonus rounds.

Applicants respectfully submit that regardless of if it would or would not have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' disclosure to incorporate a bonus round featuring the game of Tetris for the purpose of invoking player skill and strategy to determine award payoffs in bonus rounds, neither Yoseloff or Nakata individually, nor the gaming device resulting from the combination of Yoseloff and Nakata disclose a processor operable to display a play of the primary game upon a wager by a player, wherein the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any outcome of the primary game. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Yoseloff and Nakata to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

On the other hand, unlike Yoseloff and Nakata, the gaming device of amended dependent Claim 20 is directed to a gaming device including, amongst other elements, at least one processor operable to display a play of the primary game upon a wager by a player, wherein the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any outcome of the primary game. For this reason, Applicants respectfully submit that dependent Claim 20 is patentably distinguished over Yoseloff and Nakata and in condition for allowance.

The Office Action rejected Claims 6, 7, 15 to 18 and 31 to 36 under 35 U.S.C. §103(a) as being unpatentable over Yoseloff in view of U.S. Patent No. 6,315,660 to DeMar et al. ("DeMar").

Regarding Claims 6, 7 and 15 to 18, the Office Action states that DeMar discloses an embodiment in which the secondary/bonus game gives the player the opportunity to make side bets. The Office Action further states that DeMar discloses pay tables associated with primary and bonus game embodiments. The Office Action concludes that it would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' disclosure to incorporate the features of secondary game wagers and pay tables into the device of Yoseloff for the purpose of increasing bonus awards during a bonus round.

Applicants respectfully submit that regardless of if it would or would not have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' disclosure to incorporate the features of secondary game wagers and pay tables into the device of Yoseloff for the purpose of increasing bonus awards during a bonus round, neither Yoseloff or DeMar individually, nor the gaming device resulting from the combination of Yoseloff and DeMar disclose a processor which causes display of a play of the primary game upon a wager by a player, wherein the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any outcome of the primary game. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Yoseloff and DeMar to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

On the other hand, unlike Yoseloff and DeMar, the gaming devices of dependent Claims 6, 7 and 15 to 18 are each directed to a gaming device including, amongst other elements, at least one processor operable to display a play of the primary game upon a wager by a player, wherein the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any outcome of the primary game. For this reason, Applicants respectfully submit that dependent Claims 6, 7 and 15 to 18 are patentably distinguished over Yoseloff and DeMar and in condition for allowance.

Regarding amended independent Claims 31 and 34, the Office Action states that it would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' disclosure to incorporate the specific methods used for operating the gaming device for the purpose of maximizing both efficiency of the gaming system and entertainment provided to the player. Applicants respectfully disagree with such generic reasoning.

Applicants respectfully submit that regardless of if it would or would not have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' disclosure to incorporate the specific methods used for operating the gaming device for the purpose of maximizing both efficiency of the gaming system and entertainment provided to the player, unlike the method of operating a gaming device of amended independent Claim 31, neither Yoseloff or DeMar individually, nor the method of operating a gaming device resulting from the combination of Yoseloff and DeMar disclose providing at least one gaming element of a secondary game regardless of any event in the primary game and regardless of any outcome of the primary game. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Yoseloff and DeMar to result in such a method of operating a gaming device without reasonably being construed as improper hindsight reconstruction.

Moreover, unlike the method of operating a gaming device of amended independent Claim 34, neither Yoseloff or DeMar individually, nor the method of operating a gaming device resulting from the combination of Yoseloff and DeMar disclose providing at least one gaming card of a secondary game regardless of any event in the primary game and regardless of any outcome of the primary game. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Yoseloff and DeMar to result in such a method of operating a gaming device without reasonably being construed as improper hindsight reconstruction. For these reasons, Applicants respectfully submit that Claims 31 and 34 are patentably distinguished over Yoseloff and DeMar and in condition for allowance.

Claims 32, 33, 35 and 36 depend directly or indirectly from independent Claims 31 and 34 respectively, are also allowable for the reasons given with respect to Claims 31 and 34, and because of the additional features recited in these claims.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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Dated: October 4, 2007